



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,134	04/03/2001	David Wallach	WALLACH=16A	2547

1444 7590 07/01/2002

BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

EXAMINER

DAVIS, MINH TAM B

ART UNIT	PAPER NUMBER
----------	--------------

1642

DATE MAILED: 07/01/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/824,134

Applicant(s)

WALLACH ET AL.

Examiner

MINH-TAM DAVIS

Art Unit

1642

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, 11, drawn to a DNA molecule encoding the MORT-1 protein of SEQ ID NO:2, an analog and a fragment thereof, a vector comprising said DNA molecule and a host cell containing said vector, and a method for producing a polypeptide, classified in class 536, subclass 23.1.
- II. Claims 8-10, drawn to the MORT-1 protein of SEQ ID NO:2, an analog and a fragment thereof, classified in class 530, subclass 350.
- III-XX. Claims 12-13, drawn to a method for increasing the FAS-R ligand effect on cells carrying a FAS-R, comprising treating said cell with one or more of the polypeptides of SEQ ID NO:2, an analog and a fragment thereof, classified in class 514, subclass 2. It is noted that the number of possible combination of a MORT-1 polypeptide, its analogs, and its fragment was determined by a factorial calculation, that is 3 factorial, for a total of 18 groups. Each of the combination is a separate invention, that is a separate group, and **not a species**. Applicant is required to elect a single group consisting of a single combination.
- XX-XXXVIII. Claims 12-13, drawn to a method for decreasing the FAS-R ligand effect on cells carrying a FAS-R, comprising treating said cell with one or more of the polypeptides of SEQ ID NO:2, an analog and a fragment thereof, classified in class 514, subclass 2. It is noted that the number of

possible combination of a MORT-1 polypeptide, its analogs, and its fragment was determined by a factorial calculation, that is 3 factorial, for a total of 18 groups. Each of the combination is a separate invention, that is a separate group, and **not a species**. Applicant is required to elect a single group consisting of a single combination.

The inventions are distinct, each from each other because of the following reasons:

Inventions (I-II) and (III-XXXVIII) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05 (h)). In this instant case, a polypeptide could be used for several purposes, e.g. for biochemical assay, for making antibodies, and for making an affinity column to purify its antibodies; and a DNA sequence could be used for the detection of similar DNA or RNA sequences, for making an expression vector, and for producing its encoded protein.

The products of groups I-II are patentably distinct, because they are drawn to entirely different biochemicals, having different structures, biological properties and activities that are not interchangeable and cannot be used in place of each other.

The methods of groups III-XXXVIII are distinct from each other because they differ at least in objectives, reagents and/or dosages, and/or schedules used, response variables and criteria for success.

Because these inventions are distinct for the reason given above and have acquired a separate status in the art, and because the searches for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

Applicants are required under 35 USC 121 to elect a single disclosed group for prosecution on the merits to which the claims shall be restricted.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 703-305-2008. The examiner can normally be reached on 9:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANTHONY CAPUTA can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

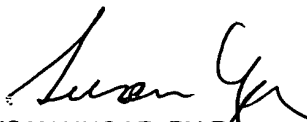
Application/Control Number: 09/824,134
Art Unit: 1642

Page 5

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.

MINH TAM DAVIS

June 17, 2002



SUSAN UNGAR, PH.D.
PRIMARY EXAMINER